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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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|-----------------|-------------|----------------------|---------------------|------------------|

10/502,411

07/23/2004

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06/30/2009

EXAMINER

RATCLIFFE, LUKE D

ART UNIT

PAPER NUMBER

3662

MAIL DATE

DELIVERY MODE

06/30/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: UWE SKULTETY-BETZ and TOBIAS CLAUDIUS

Application 10/502,411
Technology Center 3600

Mailed: June 30, 2009

Before ERIC W. HAWTHORNE, *Supervisory Paralegal Specialist*
HAWTHORNE, *Supervisory Paralegal Specialist*.

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was electronically received by the Board of Patent Appeals and Interferences on September 30, 2008. A review of the application revealed that it is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the Examiner to address the following matter(s) requiring attention prior to docketing.

FINAL REJECTION, EXAMINER'S ANSWER

A review of the filed reveals that the Final Rejection mailed on March 23, 2007¹, front page number 6 states “[c]laim(s) 1-12 is/are rejected.” The Final Rejection lists the following grounds of rejection:

Claim 1, 6, 8, 9, and 11 are rejected under 35 U.S.C. § 102(b) as being anticipated by Dunne (5949529).

Claim 7 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dunne (5949529).

Claims 3-5, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dunne (5949529) in view of Heironimus (6037874).

Page 4 of the Examiner's Answer, mailed November 16, 2007, indicates the rejection of canceled claims 4 and 5. Clarification of the status of claims 4 and 5 is required.

ACKNOWLEDGMENT OF REPLY BRIEF

On April 4, 2008, the Examiner mailed a communication acknowledging receipt of Appellants' Reply Brief, dated January 15, 2008. A review of the Response to Reply Brief reveals that the Examiner did not

¹ The Final Rejection mailed March 23, 2007, should read that it is in response to the Applicants' communication filed on December 8, 2006, in which the Appellant canceled claims 2, 4, and 5; not in response to the communication filed on July 23, 2004.

provide proper acknowledgment. The comments made by the Examiner would constitute being a Supplemental Examiner's Answer.

The Examiner's response to Reply Brief as set forth in MPEP § 1208, which states:

(1) After receipt of a reply brief in compliance with § 41.41, the primary examiner must acknowledge receipt and entry of the reply brief. In addition, the primary examiner may withdraw the final rejection and reopen prosecution or may furnish a supplemental examiner's answer responding to any new issue raised in the reply brief.

(2) A supplemental examiner's answer responding to a reply brief may not include a new ground of rejection.

(b) If a supplemental examiner's answer is furnished by the examiner, appellant may file another reply brief under § 41.41 to any supplemental examiner's answer within two months from the date of the supplemental examiner's answer.

The Communication mailed April 4, 2008, was an improper acknowledgment of the Reply Brief, as it constitutes a Supplemental Examiner's Answer as per MPEP§ 1208, part II. A Supplemental Examiner's Answers requires a Director or designees approval.

CONCLUSION

Accordingly, it is ORDERED that the application is returned to the Examiner:

- 1) for clarification of the status of claims 4 and 5, and if necessary, to vacate the Examiner's Answer mailed November 16, 2007, and issue a revised Examiner's Answer;
- 2) to vacate the Communication mailed April 4, 2008;
- 3) to generate and mail either:

a) a revised Communication properly acknowledging to the Reply Brief dated January 15, 2008 in accordance with MPEP§ 1208, part II.; OR

b) issue a Supplemental Examiner's Answer with the required signature (Technology Center Director or designee), if appropriate; and,

4) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

EWB/pgc

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